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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/730,745

12/08/2003

Todd M. Gehring

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09/08/2005

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EXAMINER

WILSON, LEE D

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/730,745 | GEHRING ET AL. | |
| | Examiner | Art Unit | |
| | LEE D. WILSON | 3723 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/16/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 4, the embodiment of Figs. 29-45 and Claims 13-43 as being readable on the elected Species 4* in the reply filed on 6/9/05 is acknowledged.

Claim Rejections - 35 USC § 112

1. Claims 13-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following claims are vague, indefinite, awkwardly and confusingly worded:

i. **Applicant should review the following rejections and upon correcting these. Make sure the dependent claims are clear in there connections in view of the changes.**

ii. Claim 1 recites both a power tool and an actuator but the specification describes these two elements as being the same thing. It is not clear if they are separate of elements or it this is a case of double inclusion.

iii. Claim 14 states that an extension sleeve and an extension projection are connected to the mounting sleeve and a power tool. The sleeve and extension are described as being connected to each other and

then the housing. The claim must recite the same mode of connection as described in the specification. Also the claim is not clear in how the connections are made for example is the housing or tool connected to the extension sleeve and then extension projection connect to the extension sleeve.

iv. Claim 25 recites both a power tool and a feed device but the specification describes these two elements as being the same thing. It is not clear if they are separate of elements or it this is a case of double inclusion.

v. Claim 25 states that an extension sleeve and an extension support is connected to the device housing and a power tool. The sleeve and extension are described as being connected to each other and then the housing. The claim must recite the same mode of connection as described in the specification.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Fujiyama et al (5899126).

Fujiyama et al discloses a fastener feed having a power tool (screw tightener) a mounting sleeve (102), a clamping block (106), and an actuator (123).

(Applicant should note that there appear to be limitation in the preamble of the claim but they are not being clear recited as part of the invention. If the applicant does not wish this to be the case please positive recite the limitations with the proper connection in regard to the structure so they parts being claimed are clear.)

Allowable Subject Matter

4. Claims 25-43 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. **(Note the preamble of the claims are unclear if they are being recited as limitations of claim or if it is function. Applicant should either change the claims or make statements to be considered.)**

5. Claims 14-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. **(Note the preamble of the claims are unclear if they are being recited as limitations of claim or if it is function. Applicant should either change the claims or make statements to be considered.)**

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Arata et al disclose a device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE D. WILSON whose telephone number is 571-272-4499. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH HAIL can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ldw

August 30, 2005



LEE D. WILSON
PRIMARY EXAMINER